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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/024,278	02/17/1998	FREDERICK S M HERZ	6099/008	8139

7590

11/19/2002

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EXAMINER

TRAN, HAI V

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 11/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/024,278

Applicant(s)

HERZ ET AL.

Examiner

Hai Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 15 and 17-43 is/are pending in the application.
- 4a) Of the above claim(s) 1-14 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15, 17-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to claims 15-20 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claims 15 and 17-43 are rejected under 35 U.S.C. 102(e) as being anticipated by Herz et al. (US 5758257).

Regarding claim 15, Herz discloses a method of providing a subscriber with program information (EPG) regarding a plurality of concurrently broadcast programs in a data distribution system (Fig. 4, 5 and 6 with multiple broadcasting sources 402)

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which comprises a multimedia broadcast medium (Broadcast network cable 610) which concurrently carries a plurality of programs, which are made available to a plurality of subscribers (set top multimedia terminals 412, 512, 620) which are connected to the multimedia broadcast medium via respective terminal adapters (each terminal has its own terminal adapter) which contain a directory member (each terminal has memory to contain particular users of household; Col. 49, lines 7-18), comprising the steps of:

Storing an entirety of directory information (all program sources available at distribution system) in a memory located in the multimedia broadcast medium (Fig. 4, element 408; Fig. 5, element 502 and Fig. 6, element 602);

Generating subscriber interest profile data which is indicative of ones of the concurrently broadcast programs which are likely to be interest to a subscriber at the subscriber terminal associated with the subscriber (Col. 38, lines 18-33 and Col. 41, lines 25-36);

Utilizing the subscriber interest profile data, excerpting a subscriber specific subset of directory information from the directory information stored in the memory (Col. 41, lines 32-41; Col. 42, lines 7-25 and Col. 43, lines 13-30);

Transmitting the excerpted directory information to the terminal adapter memory for storage therein (Col. 45, lines 11-42); and

Enabling a subscriber at the subscriber terminal device to access the excerpted directory information stored in the terminal adapter memory (Col. 45, lines 43-55).

Regarding claim 17, Herz further discloses wherein the step of managing the plurality of data items further comprises:

Calculating, in response to the subscriber accessing ones of the pluralities of broadcast programs, similarity measures to identify other likely broadcast programs of interest to the subscriber (Col. 43, lines 13-31).

Regarding claim 18, Herz further discloses wherein the step of managing the plurality of data items further comprises:

Searching, in response to the user interest profile data, the prioritized information segments of all of the data items to identifying a selected data item which most likely (optimum desirable) corresponds to the user interest profile data (Col. 43, lines 15-31).

Regarding claim 19, Herz further discloses the step of:

Scheduling activation of the step of transmitting the excerpted directory information to sequentially serve the plurality of subscriber terminals according to a determined priority schedule (Col. 41, lines 57-64).

Regarding claim 20, Herz further discloses wherein the step of scheduling comprises:

Deciding what excerpted directory information is most likely usefully broadcast to each of the plurality of subscriber terminals (Col. 41, lines 32-41).

Regarding claim 21, Herz discloses a method of optimizing communication (Col. 41, lines 25-41), comprising:

Providing at least one data source (Fig. 4, 5; element 402 and Fig. 6, element 602) of a plurality of target object data items (video/TV programs);

Providing a plurality of data terminals (Fig. 4,5 and 6; element 412,512, 620) each assigned to a particular one of a plurality of users (each terminal has multiple users of a household to access it; Col. 49, lines 7-18);

Interconnecting the at least one data source 402 and the plurality of data terminals over a communication medium (Broadcast network cable 610);

Automatically generating user interest profile data for each of the plurality of users (Col. 38, lines 18-55) which indicates which particular ones of the plurality of target object data items are likely to be of interest to each of the plurality of users (Col. 41, lines 25-36);

Searching, utilizing the user interest profile data, the plurality of target object data items to identify for each of the plurality of users at least one of the plurality of target object data items which most likely corresponds to the user interest profile data (Col. 43, lines 15-31).

Delivering the plurality of data terminals particular ones of the plurality of target object data items over a plurality of alternative virtual channels prioritized in a manner based upon the results of the step of searching (Col. 22, lines 56-63; Col. 25, lines 49-Col. 26, lines 50 and Col. 47, lines 36-52).

Regarding claim 22, Herz further discloses wherein the pluralities of target object data items comprise at least one video content (Col. 25, lines 49-Col. 26, lines 50);

Regarding claim 23, Herz further discloses wherein the data terminals comprise at least one of set to box (see Fig. 4,5 and 6).

Regarding claim 24, Herz further discloses wherein the communications medium comprises at least one of a cable television system (see Fig. 4,5 and 6).

Regarding claim 25, Herz further discloses wherein the user interest profile data is maintained in the data terminal (Col. 41, lines 4-17 and lines 59-64).

Regarding claim 26, Herz further discloses

Providing a processor in each of the data terminals (Fig. 9, 10);

Utilizing the processor to select a plurality of data items as corresponding to the user interest profile data during the step of searching, and to assign data items to virtual channels for consideration by user (Col. 40, lines 52-65).

Regarding claim 27, Herz further discloses wherein during the step of searching the processor compares directory information associated with each of the plurality of target data items to the user interest profile data to determine whether there is correspondence (Col. 22, lines 56-Col. 26, lines 50 and Col. 47, lines 36-Col. 49, lines 30).

Regarding claim 28, Herz further discloses

Collecting target data use information, such as viewing habit data, and transmitting it through the communications medium for use in refining the user interest profile data (Col. 42, lines 46-Col. 43, lines 30).

Regarding claim 29, Herz further discloses

Providing at the at least one data source a directory of descriptive information for the plurality of target object data items (Fig. 1, element 102; "program content profile"; Col. 11, lines 35-58);

Providing in a pre-selected manner for each of the plurality of users a portion of the directory of descriptive information which best matches the user interest profile of each of the plurality of users (Fig. 1, elements 106 and 108; Col. 11, lines 59-Col. 12, lines 10).

Regarding claim 30, Herz further discloses

Dividing each of the plurality of target data items into information segments (video/music clips/chunk of information; Col. 50, lines 10-15 and Col. 51, lines 1-7);  
and

During the step of delivering, transmitting the plurality of target data items in transmissions which utilize the information segments in order to reduce the effective bandwidth required for service (Col. 51, lines 32-35).

Regarding claim 31, Herz further discloses wherein, during the step of delivering, information segments of the plurality of target data items are pre-fetched in order to optimize transmission activities (Col. 51, lines 23-35);

Regarding claim 32, Herz further discloses wherein the information segments of the plurality of target data items are pre-fetched based upon known location data relative to the plurality of users (Col. 51, lines 23-35).

Regarding claim 33, method claim 33 is analyzed with respect to method claim 21. Herz further discloses



Providing a directory of information (EPG) related to the plurality of target object data types (characteristics currently in use for characterizing video programming) (Col. 11, lines 45-58 and col. 22, lines 56-Col. 23, lines 18).

Automatically generating a user-specific directory (EPG) of the plurality of target objects (video programming) for each of the plurality of users, utilizing the user interest profile data, which includes only segments of the directory of information (subsequent episodes of television series, set of movies previews) which are pertinent to that particular user (Col. 24, lines 45-55; Col. 40, lines 47-Col. 42, lines 45 and Col. 48, lines 24-55).

Providing in a pre-selected manner for each of the plurality of users, a portion of the directory of descriptive information (provide initial content profiles for new movies are made available to all) which best matches the user interest profile of each of the plurality of users (provide initial content profiles specific to a new customer to that nodes) (Col. 48, lines 24-65+).

Regarding claim 34, Herz further discloses

Providing updated directories of information related to the plurality of target data items (Col. 42, lines 1-19);

Instructing particular affected ones of the pluralities of data terminals to delete user specific directories (Col. 43, lines 24-28);

Upon detection of a request for directory information at a particular one of the plurality of data terminals, transmitting a new, updated user-specific directory to the

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particular one of the plurality of data terminals (Col. 42, lines 49-63 and Col. 43, lines 17-31).

Regarding claim 35, Herz further discloses

Periodically sending time-of-day and date information to the plurality of data terminals to allow accurate scheduling and transmission (Col. 45, lines 27-30).

Regarding claim 36, method claim 36 is analyzed with respect to claim 15. Herz further discloses producing a prioritized plurality of sets of information segments from each of the plurality of concurrently broadcast programs which are available from the data distribution system (Col. 24, lines 45-55; Col. 40, lines 47-Col. 42, lines 45 and Col. 48, lines 24-55).

Regarding claim 37, Herz further discloses wherein the step of excerpting a subscriber specific subset of directory information comprises

Generating subscriber interest profile data which is indicated of ones of the concurrently broadcast programs which are likely to be of interest to a subscriber at the terminal adapter associated with the subscriber (Col. 38, lines 18-33 and Col. 41, lines 25-36);

Regarding claim 38, method claim 38 is analyzed with respect to claim 17.

Regarding claim 39, method claim 39 is analyzed with respect to claim 19.

Regarding claim 40, method claim 40 is analyzed with respect to claim 20.

Regarding claims 41-43, Herz further discloses wherein the step of providing data to the terminal adapter comprises:

In response to the user inputting data at the terminal adapter to select one (select infomercials while watching a movie from EPG) of the plurality of data items, data representative of a 2<sup>nd</sup> (display products available to purchase) of the prioritized plurality of sets of information segment of the selected one of the plurality of data items;

In response to transmission of the 2<sup>nd</sup> of the prioritized plurality of sets of information segment of the selected one of the plurality of data items, data representative of at least a 3<sup>rd</sup> (respond to the selection of a product by making purchase) of the prioritized plurality sets of information segments of the selected one of the plurality of data items;

In response to the user inputting data at the terminal adapter to request the entirety of the selected one of the plurality of data items (select infomercials while watching movie), data representative of all of the prioritized plurality sets of information segments of the selected one of the plurality of data items (display all products available to purchase) (Col. 47, lines 36-65+).

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

- Claims 15, 17-20 are rejected under the judicially created doctrine of double patenting over claims 9 and 53 of U. S. Patent No. 5,758,257 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are different definitions or descriptions of the same subject matter, varying in breadth.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

- a. In claim 15 of the current application "a method of providing a subscriber with program information regarding a plurality of concurrently broadcast programs in a data distribution system which comprises a multimedia broadcast medium which concurrently carries a plurality of programs, which are made available to a plurality of subscribers which are connected to the multimedia

broadcast medium via respective terminal adapters which contain a directory member" corresponds to "a method of scheduling transmission of video programs to a plurality of customers" of patent's claim 9 and "scheduling transmission of video programs from a video head end to a plurality of customers" of patent's claim 53.

- b. "Storing an entirety of directory information in a memory located in the multimedia broadcast medium" corresponds "determining from a the agreement matrix a subset of the video programs having content profiles which most closely match the at least one customer profile" of patent claims 9 and 53. It is inherent that in order to determine from a the agreement matrix a subset of the video programs, an entirety of directory of information must be stored in a memory located in the multimedia broadcast medium of the head end.
- c. "Generating subscriber interest profile data which is indicative of ones of the concurrently broadcast programs which are likely to be interest to a subscriber at the subscriber terminal associated with the subscriber" corresponds to "creating a plurality of customer profiles for each of the plurality of customers of the video programs..." of patent claim 9 and "a plurality of customer profiles for each of the plurality of customers of the video programs..." of patent claim 53.
- d. "Utilizing the subscriber interest profile data, excerpting a subscriber specific subset of directory information from the directory information stored in the

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memory" corresponds to "determining from a the agreement matrix a subset of the video programs having content profiles which most closely match the at least one customer profile" of patent claims 9 and 53.

- e. "Transmitting the excerpted directory information to the terminal adapter memory for storage therein" correspond to "scheduling the subset of video programs for transmission from a video head end to the plurality of customers for receipt on the customers' television" of patent claims 9 and 53.
- f. "Enabling a subscriber at the subscriber terminal device to access the excerpted directory information stored in the terminal adapter memory" corresponds to "scheduling the subset of video programs for transmission from a video head end to the plurality of customers for receipt on the customers' television" of patent claims 9 and 53. It is inherent that once the subset of video programs received at the customer site, the customer is able to access for viewing.

Similarly claims 17-20 correspond to the patent claims 9 and 53.

Allowance of claims 15-20 would result in a time wise extension of the monopoly previously granted for the invention defined in patent claims 9 and 53.

- Claims 21-32 are rejected under the judicially created doctrine of double patenting over claims 2 and 45 of U. S. Patent No. 5,758,257 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they are different definitions or descriptions of the same subject matter, varying in breadth. The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are different definitions or descriptions of the same subject matter, varying in breadth.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

- a. In claim 21 of the current application "a method of optimizing communication" corresponds to "a method of scheduling customer access to video programs" of patent's claim 2 and "a data transmission which schedules customer access to video programs received from video head end" of patent's claim 45.
- b. "Providing at least one data source of a plurality of target object data items" corresponds to "determining from the agreement matrix a subset of the video programs having content profiles which most closely match the at least one customer profile" of patent's claims 2 and 45. It is inherent

that in order for determining from the agreement matrix a subset of the video programs, the head end must have at least one data source of a plurality of target object data items.

- c. "Providing a plurality of data terminals, each assigned to a particular one of a plurality of users" corresponds to "creating at least one customer profile for each customer of the video programs, the customer profile indicating the customer's preferences for predetermined characteristics of the video programs" of patent's claims 2 and 45. It is inherent that in order to create at least one customer profile for each customer of the video programs, the system must have a plurality of terminals/set top terminals wherein each household have at least a unique set top terminal with plurality of users in which each user has its own profile.
- d. "Interconnecting the at least one data source and the plurality of data terminals over a communications medium" corresponds to "presenting the subset of video programs to the customer as at least one "virtual channel" for display on customer's television" of patent's claims 2 and 45. It is inherent that in order to present the subset of video programs to the customer, the system must have a communication link between the customer premises and the head end.
- e. "Automatically generating user interest profile data for each of the plurality of users which indicates which particular ones of the plurality of target object data items are likely to be of interest to each of the plurality of



users" corresponds to "creating at least one customer profile for each customer of the video programs, the customer profile indicating the customer's preferences for predetermined characteristics of the video programs" of patent's claims 2 and 45.

- f. "Searching, utilizing the user interest profile data, the plurality of target object data items to identify for each of the plurality of users at least one of the plurality of target object data items which most likely corresponds to the user interest profile data" corresponds to "determining from the agreement matrix a subset of the video programs having content profiles which most closely match the at least one customer profile" of patent's claims 2 and 45.
- g. "Delivering the plurality of data terminals particular ones of the plurality of target object data items over a plurality of alternative virtual channels prioritized in a manner based upon the results of the step of searching" corresponds to "presenting the subset of video programs to the customer as at least one "virtual channel" for display on customer's television" of patent's claims 2 and 45.

Similarly claims 22-32 correspond to the patent's claims 2 and 45.

Allowance of claims 21-32 would result in a time wise extension of the monopoly previously granted for the invention defined in patent's claims 2 and 45.

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- Claims 33-35 are rejected under the judicially created doctrine of double patenting over claims 2 and 45 of U. S. Patent No. 5,758,257 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they are different definitions or descriptions of the same subject matter, varying in breadth.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are different definitions or descriptions of the same subject matter, varying in breadth.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

- a. In claim 33 of the current application "a method of optimizing communication" corresponds to "a method of scheduling customer access to video programs" of patent's claim 2 and "a data transmission which schedules customer access to video programs received from video head end" of patent's claim 45.

- b. "Providing at least one data source of a plurality of target object data items" and "Providing a directory of information related to the plurality of target object data types" correspond to "determining from the agreement matrix a subset of the video programs having content profiles which most closely match the at least one customer profile" of patent's claims 2 and 45. It is inherent that in order for determining from the agreement matrix a subset of the video programs, the head end must have at least one data source of a plurality of target object data items and a directory of information related to the plurality of target object data types".
- c. "Providing a plurality of data terminals, each assigned to a particular one of a plurality of users" corresponds to "creating at least one customer profile for each customer of the video programs, the customer profile indicating the customer's preferences for predetermined characteristics of the video programs" of patent's claims 2 and 45. It is inherent that in order to create at least one customer profile for each customer of the video programs, the system must have a plurality of terminals/set top terminals wherein each household have at least a unique set top terminal with plurality of users in which each user has its own profile.
- d. "Interconnecting the at least one data source and the plurality of data terminals over a communications medium" corresponds to "presenting

the subset of video programs to the customer as at least one "virtual channel" for display on customer's television" of patent's claims 2 and 45. It is inherent that in order to present the subset of video programs to the customer, the system must have a communication link between the customer premises and the head end.

- e. "Automatically generating user interest profile data for each of the plurality of users which indicates which particular ones of the plurality of target object data items are likely to be of interest to each of the plurality of users" corresponds to "creating at least one customer profile for each customer of the video programs, the customer profile indicating the customer's preferences for predetermined characteristics of the video programs" of patent's claims 2 and 45.
- f. "Automatically generating a user-specific directory of the plurality of target objects for each of the plurality of users, utilizing the user interest profile data, which includes only segments of the directory of information which are pertinent to that particular user" corresponds to "determining from the agreement matrix a subset of the video programs having content profiles which most closely match the at least one customer profile" of patent's claims 2 and 45. The claimed limitation is inherent since the system must performs the claimed function so to determine from the agreement matrix a subset of the

video programs having content profiles which most closely match the at least one customer profile.

- g. "Searching, utilizing the user interest profile data and the user-specific directory of the plurality of target data objects, the plurality of target object data items to identify for each of the plurality of users at least one of the plurality of target object data items which most likely corresponds to the user interest profile data" corresponds to "determining from the agreement matrix a subset of the video programs having content profiles which most closely match the at least one customer profile" of patent's claims 2 and 45.
- h. "Delivering the plurality of data terminals particular ones of the plurality of target object data items prioritized in a manner based upon the results of the step of searching" corresponds to "presenting the subset of video programs to the customer as at least one "virtual channel" for display on customer's television" of patent's claims 2 and 45.
- i. "Providing in a pre-selected manner for each of the plurality of users a portion of the directory of descriptive information which best matches the user interest profile of each of the plurality of users" corresponds to "presenting the subset of video programs to the customer as at least one "virtual channel" for display on customer's television" of patent's claims 2 and 45. The claimed limitation is inherent since the system

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must perform the claimed function so to present the subset of video programs to the corresponding customer.

Similarly claims 34-35 correspond to the patent's claims 2 and 45.

Allowance of claims 33-35 would result in a time wise extension of the monopoly previously granted for the invention defined in patent's claims 2 and 45.

- Claims 36-43 are rejected under the judicially created doctrine of double patenting over claims 9 and 53 of U. S. Patent No. 5,758,257 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they are different definitions or descriptions of the same subject matter, varying in breadth. The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are different definitions or descriptions of the same subject matter, varying in breadth.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

- a. In claim 36 of the current application “a method of providing a subscriber with program information regarding a plurality of concurrently broadcast programs in a data distribution system which comprises a multimedia broadcast medium which concurrently carries a plurality of programs, which are made available to a plurality of subscribers which are connected to the multimedia broadcast medium via respective terminal adapters which contain a directory member” corresponds to “a method of scheduling transmission of video programs to a plurality of customers” of patent’s claim 9 and “scheduling transmission of video programs from a video head end to a plurality of customers” of patent’s claim 53.
- b. “Storing an entirety of directory information, that describes the plurality of concurrently broadcast programs, in a memory located in the data distribution system” corresponds “determining from a the agreement matrix a subset of the video programs having content profiles which most closely match the at least one customer profile” of patent’s claims 9 and 53. It is inherent that in order to determine from a the agreement matrix a subset of the video programs, an entirety of directory of information must be stored in a memory located in the multimedia broadcast medium of the head end.
- c. “Producing a prioritized plurality of sets of information segments from each of the plurality of concurrently broadcast programs which are available from the data distribution system” corresponds to “means for scheduling

the subset of video programs for transmission from the video head end to the plurality of customers for receipt on the customers' television" of patent's claim 53.

- d. "Excerpting a subscriber specific subset of directory information from the directory information stored in the memory" corresponds to "determining from a the agreement matrix a subset of the video programs having content profiles which most closely match the at least one customer profile" of patent's claims 9 and 53.
- e. "Transmitting the excerpted directory information to the terminal adapter directory memory for storage therein" correspond to "scheduling the subset of video programs for transmission from a video head end to the plurality of customers for receipt on the customers' television" of patent's claims 9 and 53.
- f. "Enabling a subscriber at the terminal adapter to access the excerpted directory information stored in the terminal adapter directory memory" corresponds to "scheduling the subset of video programs for transmission from a video head end to the plurality of customers for receipt on the customers' television" of patent claims 9 and 53. It is inherent that once the subset of video programs received at the customer site, the customer is able to access for viewing.

Similarly claims 37-43 correspond to the patent claims 9 and 53.



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Allowance of claims 36-43 would result in a time wise extension of the monopoly previously granted for the invention defined in patent claims 9 and 53.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Tran whose telephone number is 703-308-7372. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 703-305-4380. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.



ANDREW FAILE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

HT:ht  
November 14, 2002